REMARKS

In the Office Action mailed November 29, 2006, the Office Action rejected claims 42-46 under 35 U.S.C. § 102. The Office Action also rejected claims 1-5, 9, 11-15, 18-22 and 27-41 under 35 U.S.C. § 103. Claims 1, 18, 29, 36, 39, 42 and 45 have been amended.

Applicants respectfully respond to this Office Action.

I. Claims 42-46 Rejected under 35 U.S.C. § 102

The Office Action rejected claims 42-46 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,802,149 to Hanson (hereinafter, "Hanson"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Appellants respectfully submit that the claims at issue are patentably distinct from Hanson. Hanson does not disclose all of the limitations in these claims.

Claim 42, as amended, recites "wherein said feature resides on said wireless communication device." Support for this amendment may be found in Applicants' specification, page 5, lines 5-7; page 6, lines 6-8 and lines 26-29; page 9, lines 4-7 and page 13, lines 19-21. Hanson does not disclose this claim element.

In contrast, Hanson states "[a] voice-dialing system 107 that is connected as an adjunct processor to switching center 104 provides users of telephones 100-101 with voice-dialing capability." Hanson, col. 3, lines 26-28. The Office Action refers to this sentence of Hanson to support the assertion that because "a voice-dialing system 107 provides users of telephones [i.e., wireless communication device] with voice dialing capability . . . it is clear that the voice dialing

feature is of the wireless communication device." Office Action, page 5. However, Hanson further discloses:

> [A] telecommunications system comprising a plurality of portable telephones 100-101 selectively connected via radiotelephone/wireless connections to base stations 102-103 and therethrough to a switching center 104.

Hanson, col. 3, lines 6-9.

Hanson discloses "[a] voice-dialing system . . . connected . . . to switching center." Figure 1 of Hanson illustrates that the voice-dialing system and switching center are clearly separate from the plurality of portable telephones. A voice-dialing system that "provides users of telephones with voice-dialing capability" and is separate from the portable telephones does not disclose "wherein said feature resides on said wireless communication device."

In addition, Hanson states "[figs.] 2-3 are a function flow diagram of operation of the voice-dialing system of the telecommunications system of FIG. 1." Hanson, col. 3, lines 1-3. Regarding the flow of FIG. 2, Hanson states "[w]hen a user of a telephone 100 initiates a call, switching center 104 connects the caller to voice-dialing system 107." Hanson, col. 3, lines 52-53. Connecting a telephone to a voice-dialing system clearly discloses that the telephone and the voice-dialing system are separate. Hanson does not disclose that the function of the flow diagram of FIG. 2 could be performed by the portable telephones.

As previously mentioned, Hanson states "[a] voice-dialing system . . . provides users of telephones . . . with voice-dialing capabilities." Because Hanson discloses that the portable telephones and the voice-dialing system are separate, Hanson does not disclose "wherein said feature resides on said wireless communication device" as claimed by Applicants.

In view of the foregoing, Applicants respectfully submit that claim 42 is patentably distinct from Hanson. Accordingly, Applicants respectfully request that the rejection of claim 42 be withdrawn.

Claims 43-44 depend directly from claim 42. Accordingly, Applicants respectfully request that the rejection of claims 43-44 be withdrawn for at least the same reasons as those presented above in connection with claim 42 because Hanson does not disclose all of the claim elements of claim 42.

Claim 45, as amended, recites "wherein said first feature resides on said wireless communication device . . . wherein said second feature resides on said wireless communication device." Support for this amendment may be found in Applicants' specification, page 5, lines 5-7; page 6, lines 6-8 and lines 26-29; page 9, lines 4-7 and page 13, lines 19-21. Hanson does not disclose this claim element.

In contrast, Hanson states "[a] voice-dialing system 107 that is connected as an adjunct processor to switching center 104 provides users of telephones 100-101 with voice-dialing capability." Hanson, col. 3, lines 26-28. The Office Action refers to this sentence of Hanson to support the assertion that because "a voice-dialing system 107 provides users of telephones [i.e., wireless communication device] with voice dialing capability . . . it is clear that the voice dialing feature is of the wireless communication device." Office Action, page 5. However, Hanson further discloses:

> [A] telecommunications system comprising a plurality of portable telephones 100-101 selectively connected via radiotelephone/wireless connections to base stations 102-103 and therethrough to a switching center 104.

Hanson, col. 3, lines 6-9.

Hanson discloses "[a] voice-dialing system . . . connected . . . to switching center." Figure 1 of Hanson illustrates that the voice-dialing system and switching center are clearly separate from the plurality of portable telephones. A voice-dialing system that "provides users of telephones with voice-dialing capability" and is separate from the portable telephones does not disclose "wherein said first feature resides on said wireless communication device . . . wherein said second feature resides on said wireless communication device."

In addition, Hanson states "[figs.] 2-3 are a function flow diagram of operation of the voice-dialing system of the telecommunications system of FIG. 1." Hanson, col. 3, lines 1-3. Regarding the flow of FIG. 2, Hanson states "[w]hen a user of a telephone 100 initiates a call, switching center 104 connects the caller to voice-dialing system 107." Hanson, col. 3, lines 52-53. Connecting a telephone to a voice-dialing system clearly discloses that the telephone and the voice-dialing system are separate. Hanson does not disclose that the function of the flow diagram of FIG. 2 could be performed by the portable telephones.

As previously mentioned, Hanson states "[a] voice-dialing system . . . provides users of telephones . . . with voice-dialing capabilities." Because Hanson discloses that the portable telephones and the voice-dialing system are separate, Hanson does not disclose "wherein said first feature resides on said wireless communication device . . . wherein said second feature resides on said wireless communication device" as claimed by Applicants.

In view of the foregoing, Applicants respectfully submit that claim 45 is patentably distinct from Hanson. Accordingly, Applicants respectfully request that the rejection of claim 45 be withdrawn.

Claim 46 depends directly from claim 45. Accordingly, Applicants respectfully request that the rejection of claim 46 be withdrawn for at least the same reasons as those presented above in connection with claim 45 because Hanson does not disclose all of the claim elements of claim 45.

II. Claims 1-5, 9, 11, 13, 14, 18-22 and 27 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 1-5, 9, 11, 13, 14, 18-22 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of U.S. Patent No. 5, 978,671 to Foladare et al. (hereinafter, "Foladare"). This rejection is respectfully traversed.

The M.P.E.P. states that

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claim at issue is patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in this claim.

Claim 1, as amended, recites "wherein the incoming call is received by a wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 7-9, and lines 23-27. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states "[w]hen a user of a telephone 100 initiates a call, switching center 104 connects the caller to voice-dialing system 107." Hanson, col. 3, lines 52-53. The Office Action refers to this sentence of Hanson to support the assertion that "Hanson teaches receiving an incoming call from a first telephone number." Office Action, page 7. However, the switching center and the voice-dialing system receiving a call does not teach, suggest or disclose "wherein the incoming call is received by a wireless communication device."

Figure 1 of Hanson teaches that the voice-dialing system and switching center are clearly separate from the plurality of portable telephones. A switching center and a voice-dialing system that are separate from the portable telephones do not teach, suggest or disclose "wherein the incoming call is received by a wireless communication device."

In addition, Hanson states "[figs.] 2-3 are a function flow diagram of operation of the voice-dialing system of the telecommunications system of FIG. 1." Hanson, col. 3, lines 1-3. Regarding the flow of FIG. 2, as previously stated, Hanson teaches "[w]hen a user of a telephone 100 initiates a call, switching center 104 connects the caller to voice-dialing system 107." Hanson, col. 3, lines 52-53. Connecting a telephone to a voice-dialing system clearly discloses that the telephone and the voice-dialing system are separate. Hanson does not disclose that the function of the flow diagram of FIG. 2 could be performed by the portable telephones.

Because Hanson discloses that the portable telephones are separate from the switching center and the voice-dialing system, Hanson does not teach, suggest or disclose "wherein the incoming call is received by a wireless communication device" as claimed by Applicants. The Office Action has not asserted that Foladare teaches, suggests or discloses this claim element.

Claim 1, is further amended to recite "incrementing a variable indicating a number of calls received by the wireless communication device." Support for this amendment may be

found in Applicants' specification, page 7, lines 13-16 and 23-27. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare teaches:

> In accordance with the method 100, in step 105, a caller dials a called party's telephone number using the calling telephone 10 . . . the method 100 can also be used to prompt the subscriber to enter an alphanumeric identifier after any threshold number of times a particular caller has called. For example, a value indicating the number of times a particular caller has called can be maintained in the database 55 and cross-referenced with the caller identity information that was stored in step 130. Then, the method would perform steps 155 and 160 only after that value has reached the particular threshold number of repeat calls.

Foladare, col. 5, lines 40-42 and col. 6, lines 38-47.

Using the calling telephone to dial a called party's telephone number does not teach, suggest or disclose "incrementing a variable indicating a number of calls received by the wireless communication device." A value indicating the number of times a particular caller has called also does not teach, suggest or disclose "incrementing a variable indicating a number of calls received by the wireless communication device."

Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "incrementing a variable indicating a number of calls received by the wireless communication device." The Office Action admits that Hanson does not teach, suggest or disclose this claim element.

Claim 1 is further amended to recite "prompting a user of the wireless communication device with a first prompt to save said first telephone number." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare states "the subscriber is prompted to enter an alphanumeric identifier corresponding to the caller's audible identifier, as well as the previously stored audible identifier if no alphanumeric identifier is associated with it." Foladare, col. 8, lines 18-21. Foladare further states "the subscriber can originate a return telephone call from any telephone such as the telephone 75." Foladare, col. 5, lines 5-7. As previously stated, Figure 1 of Foladare teaches a

wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a user of the wireless communication device." The Office Action admits that Hanson does not teach, suggest or disclose this claim element.

Claim 1 has also been amended to recite "checking whether a first voice tag . . . has already been saved within the wireless communication device." Support for this amendment may be found in Applicants' specification, page 10, lines 23-25. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

As previously mentioned, the voice dialing system of Hanson does not teach, suggest or disclose "the wireless communication device." Hanson states "[figs.] 2-3 are a function flow diagram of operation of the voice-dialing system of the telecommunications system of FIG. 1." Hanson, col. 3, lines 1-3. Hanson does not disclose that the function of the flow diagram of FIG. 2 could be performed by the portable telephones. Regarding the flow of FIG. 2, Hanson teaches "[i]f it is determined at step 210 that the tag that was received from the caller at step 204 does not match any of the tags that are stored in the caller's voice-dialing directory 130, system 107 announces that the tag was not recognized." Hanson, col. 4, lines 5-8. Hanson states that "system 107 has stored in memory 112 a database of voice-dialing directories." Hanson, col. 3, lines 40-42. As such, the voice-dialing system determine[ing] if the tag matches tags "that are stored in the caller's voice-dialing directory" does not teach, suggest or disclose "checking whether a first voice tag . . . has already been saved within the wireless communication device."

Because Hanson discloses that the portable telephones are separate from the switching center and the voice-dialing system, Hanson does not teach, suggest or disclose "checking whether a first voice tag . . . has already been saved within the wireless communication device" as claimed by Applicants. The Office Action has not asserted that Foladare teaches, suggests or discloses this claim element.

Claim 1 has further been amended to recite "storing said first telephone number and an acceptable recording quality voice tag within the wireless communication device." Support for this amendment may be found in Applicants' specification, page 13, lines 3-10. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states "[s]ystem 107 . . . stores this resulting voice tag and the number that it obtained at step 234 as an entry in the caller's voice-dialing directory 130, at step 246." Storing the voice tag and the number in the voice-dialing directory does not teach, suggest or disclose "storing said first telephone number and an acceptable recording quality voice tag within the wireless communication device." The voice-dialing directory is stored within the voice-dialing system. See Hanson, col. 3, lines 40-42. As mentioned, the voice-dialing system does not teach, suggest or disclose "the wireless communication device." As such, storing the voice tag and number in the voice-dialing directory does not teach, suggest or disclose "storing said first telephone number and an acceptable recording quality voice tag within the wireless communication device." The Office Action has not asserted that Foladare teaches, suggests or discloses this claim element.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Hanson and Foladare, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2-5, 9, 11, 13 and 14 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-5, 9, 11, 13 and 14 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Hanson and Foladare, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 1.

Claim 18, as amended, recites "a receiver in a wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 7-9, and lines 23-27. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states "[w]hen a user of a telephone 100 initiates a call, switching center 104 connects the caller to voice-dialing system 107." Hanson, col. 3, lines 52-53. The Office Action refers to this sentence of Hanson to support the assertion that "Hanson teaches receiving an incoming call from a first telephone number." Office Action, page 7. However, the switching center and the voice-dialing system receiving a call does not teach, suggest or disclose "a receiver in a wireless communication device."

Figure 1 of Hanson teaches that the voice-dialing system and switching center are clearly separate from the plurality of portable telephones. A switching center and a voice-dialing system that are separate from the portable telephones do not teach, suggest or disclose "a receiver in a wireless communication device."

In addition, Hanson states "[figs.] 2-3 are a function flow diagram of operation of the voice-dialing system of the telecommunications system of FIG. 1." Hanson, col. 3, lines 1-3. Regarding the flow of FIG. 2, as previously stated, Hanson teaches "[w]hen a user of a telephone 100 initiates a call, switching center 104 connects the caller to voice-dialing system 107." Hanson, col. 3, lines 52-53. Connecting a telephone to a voice-dialing system clearly discloses that the telephone and the voice-dialing system are separate. Hanson does not disclose that the function of the flow diagram of FIG. 2 could be performed by the portable telephones.

Because Hanson discloses that the portable telephones are separate from the switching center and the voice-dialing system, Hanson does not teach, suggest or disclose "a receiver in a wireless communication device" as claimed by Applicants. The Office Action has not asserted that Foladare teaches, suggests or discloses this claim element.

Claim 18, is further amended to recite "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 13-16 and 23-27. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare teaches:

> In accordance with the method 100, in step 105, a caller dials a called party's telephone number using the calling telephone 10 . . . the method 100 can also be used to prompt the subscriber to enter an alphanumeric identifier after any threshold number of times a particular caller has called. For example, a value indicating the number of times a particular caller has called can be maintained in the database 55 and cross-referenced with the caller identity information that was stored in step 130. Then, the method would perform steps 155 and 160 only after that value has reached the particular threshold number of repeat calls.

Foladare, col. 5, lines 40-42 and col. 6, lines 38-47.

Using the calling telephone to dial a called party's telephone number does not teach, suggest or disclose "a CPU in the wireless communication device configured to increment a

variable indicating a number of calls received by the wireless communication device." A value indicating the number of times a particular caller has called also does not teach, suggest or disclose "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device."

Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device." The Office Action admits that Hanson does not teach, suggest or disclose this claim element.

Claim 18 is further amended to recite "a user interface adapter in the wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27; page 10, lines 23-25 and page 13, lines 3-10. Hanson and Foladare, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare states "the subscriber is prompted to enter an alphanumeric identifier corresponding to the caller's audible identifier, as well as the previously stored audible identifier if no alphanumeric identifier is associated with it." Foladare, col. 8, lines 18-21. Foladare further states "the subscriber can originate a return telephone call from any telephone such as the telephone 75." Foladare, col. 5, lines 5-7. As previously stated, Figure 1 of Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a user interface adapter in the wireless communication device."

In view of the foregoing, Applicants respectfully submit that claim 18 is patentably distinct from Hanson and Foladare, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 18 be withdrawn.

Claims 19-22 and 27 depend directly from claim 18. Accordingly, Applicants respectfully request that the rejection of claims 19-22 and 27 be withdrawn for at least the same reasons as those presented above in connection with claim 18 because Hanson and Foladare, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 18.

III. Claims 1-5, 11, 13, 14, 18-22 and 27 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 1-5, 11, 13, 14, 18-22 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of U.S. Patent No. 4,994,983 to Landell et al. (hereinafter, "Landell"). This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above. (See M.P.E.P. § 2142.)

Applicants respectfully submit that the claim at issue is patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in this claim.

Claim 1, as amended, recites "wherein the incoming call is received by a wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 7-9, and lines 23-27. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "wherein the incoming call is received by a wireless communication device."

Because Foladare teaches that the telephones are wired Foladare does not teach, suggest or disclose "wherein the incoming call is received by a wireless communication device" as claimed by Applicants. The Office Action has not asserted that Landell teaches, suggests or discloses this claim element.

Claim 1, is further amended to recite "incrementing a variable indicating a number of calls received by the wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 13-16 and 23-27. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare teaches:

> In accordance with the method 100, in step 105, a caller dials a called party's telephone number using the calling telephone 10 . . . the method 100 can also be used to prompt the subscriber to enter an alphanumeric identifier after any threshold number of times a particular caller has called. For example, a value indicating the number of times a particular caller has called can be maintained in the database 55 and cross-referenced with the

> caller identity information that was stored in step 130. Then, the method would perform steps 155 and 160 only after that value has reached the particular threshold number of repeat calls.

Foladare, col. 5, lines 40-42 and col. 6, lines 38-47.

Using the calling telephone to dial a called party's telephone number does not teach, suggest or disclose "incrementing a variable indicating a number of calls received by the wireless communication device." A value indicating the number of times a particular caller has called also does not teach, suggest or disclose "incrementing a variable indicating a number of calls received by the wireless communication device."

Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "incrementing a variable indicating a number of calls received by the wireless communication device."

Claim 1 is further amended to recite "prompting a user of the wireless communication device with a first prompt to save said first telephone number." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare states "the subscriber is prompted to enter an alphanumeric identifier corresponding to the caller's audible identifier, as well as the previously stored audible identifier if no alphanumeric identifier is associated with it." Foladare, col. 8, lines 18-21. Foladare further states "the subscriber can originate a return telephone call from any telephone such as the telephone 75." Foladare, col. 5, lines 5-7. As previously stated, Figure 1 of Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a user of the wireless communication device."

Claim 1 has also been amended to recite "checking whether a first voice tag . . . has already been saved within the wireless communication device." Support for this amendment may be found in Applicants' specification, page 10, lines 23-25. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

As previously mentioned, Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "checking whether a first voice tag . . . has already been saved within the wireless communication device."

Because Foladare teaches that the telephones are wired Foladare does not teach, suggest or disclose "checking whether a first voice tag . . . has already been saved within the wireless communication device" as claimed by Applicants. The Office Action has not asserted that Landell teaches, suggests or discloses this claim element.

Claim 1 has further been amended to recite "storing said first telephone number and an acceptable recording quality voice tag within the wireless communication device." Support for this amendment may be found in Applicants' specification, page 13, lines 3-10. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

As previously mentioned, Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "checking whether a first voice tag . . . has already been saved within the wireless communication device."

Because Foladare teaches that the telephones are wired Foladare does not teach, suggest or disclose "storing said first telephone number and an acceptable recording quality voice tag within the wireless communication device" as claimed by Applicants. The Office Action has not asserted that Landell teaches, suggests or discloses this claim element.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Foladare and Landell, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2-5, 11, 13 and 14 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-5, 11, 13 and 14 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Foladare

and Landell, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 1.

Claim 18, as amended, recites "a receiver in a wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 7-9, and lines 23-27. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a receiver in a wireless communication device."

Because Foladare teaches that the telephones are wired Foladare does not teach, suggest or disclose "a receiver in a wireless communication device" as claimed by Applicants. The Office Action has not asserted that Landell teaches, suggests or discloses this claim element.

Claim 18, is further amended to recite "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 13-16 and 23-27. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare teaches:

> In accordance with the method 100, in step 105, a caller dials a called party's telephone number using the calling telephone 10 . . . the method 100 can also be used to prompt the subscriber to enter an alphanumeric identifier after any threshold number of times a particular caller has called. For example, a value indicating the number of times a particular caller has called can be maintained in the database 55 and cross-referenced with the caller identity information that was stored in step 130. Then, the method would perform steps 155 and 160 only after that value has reached the particular threshold number of repeat calls.

Foladare, col. 5, lines 40-42 and col. 6, lines 38-47.

Using the calling telephone to dial a called party's telephone number does not teach, suggest or disclose "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device." A value

indicating the number of times a particular caller has called also does not teach, suggest or disclose "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device."

Foladare teaches "a communication system 1 that stores subscriber defined alphanumeric identifiers." Foladare, col. 3, lines 57-58 and Figure 1. However, as Figure 1 indicates, Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a CPU in the wireless communication device configured to increment a variable indicating a number of calls received by the wireless communication device."

Claim 18 is further amended to recite "a user interface adapter in the wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27; page 10, lines 23-25 and page 13, lines 3-10. Foladare and Landell, alone or in combination, do not teach, suggest or disclose this claim element.

Foladare states "the subscriber is prompted to enter an alphanumeric identifier corresponding to the caller's audible identifier, as well as the previously stored audible identifier if no alphanumeric identifier is associated with it." Foladare, col. 8, lines 18-21. Foladare further states "the subscriber can originate a return telephone call from any telephone such as the telephone 75." Foladare, col. 5, lines 5-7. As previously stated, Figure 1 of Foladare teaches a wired telephone (10 and 75) that is connected to a central office. See, Foladare, Figure 1. As such, Foladare does not teach, suggest or disclose "a user interface adapter in the wireless communication device."

In view of the foregoing, Applicants respectfully submit that claim 18 is patentably distinct from Foladare and Landell, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 18 be withdrawn.

Claims 19-22 and 27 depend directly from claim 18. Accordingly, Applicants respectfully request that the rejection of claims 19-22 and 27 be withdrawn for at least the same reasons as those presented above in connection with claim 18 because Foladare and Landell, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 18.

IV. Claims 9 and 15 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 9 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Landell further in view of U.S. Patent No. 5,982,857 to Brady (hereinafter, "Brady"). This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above. (See M.P.E.P. § 2142.)

Claims 9 and 15 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 9 and 15 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Foladare, Landell and Brady, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 1.

V. Claims 12 and 28 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 12 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Landell further in view of U.S. Patent No. 5,898,392 to Bambini et al. (hereinafter, "Bambini"). This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above. (See M.P.E.P. § 2142.)

Claim 12 depends indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claim 12 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Foladare, Landell and Bambini, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 1.

Claim 28 depends indirectly from claim 18. Accordingly, Applicants respectfully request that the rejection of claim 28 be withdrawn for at least the same reasons as those presented above in connection with claim 18 because Foladare, Landell and Bambini, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 18.

VI. Claims 29-41 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 29-41 under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of U.S. Patent No. 6,377,820 to Courtis et al. (hereinafter, "Courtis"). This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above. (See M.P.E.P. § 2142.)

Claim 29 has been amended to recite "wherein a wireless communication device receives the voice tag." Support for this amendment may be found in Applicants' specification, page 13, lines 3-10. Hanson and Courtis, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states:

> Upon receipt of the tag, at step 204, system 107 stores the received tag, at step 206, and then searches the caller's voice-dialing directory 130 in an attempt to match the received tag with one of the tags stored in voice-dialing directory 130, at step 208.

Hanson, col. 3, lines 59-63.

The Office Action refers to this passage of Hanson to support the assertion that Hanson teaches "receiving a voice tag corresponding to a first telephone number." Office Action, page 14. However, the system 107 does not teach, suggest or disclose "a wireless communication device" because the system 107 taught in Hanson is clearly separate from the portable telephones as previously explained.

Claim 29 has also been amended to recite "prompting a user of the wireless communication device." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27. Hanson and Courtis, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states "system 107 proceeds conventionally, at step 224, by asking the caller to either repeat the tag or to speak a new tag." Hanson, col. 4, lines 12-14. Once again, a user of the system 107 does not teach, suggest or disclose "prompting a user of the wireless communication device" because Hanson clearly teaches that the system 107 is completely separate from the portable telephones. See Figure 1 of Hanson.

Courtis states:

> The generating means may generate digits of a telephone number in response to information input by a user via the switch and microphone. Alternatively, the generating means may generate a voice tag for storing in the telephone in association with a telephone number.

Courtis, col. 2, lines 34-37.

While Courtis teaches "a voice tag for storing in the telephone," Applicants submit that combining Hanson and Courtis would render either Hanson or Courtis unsatisfactory for its

intended purpose. See MPEP § 2145. For example, the Office Action refers to the above cited passage of Courtis to support the assertion that Courtis teaches "storing/saving voice tag . . . at the wireless communication device." However, Hanson teaches (as provided above) that system 107 stores the received tag. As previously mentioned, the system 107 of Hanson is clearly separate from the wireless communication device (i.e., telephone of Courtis). As such, combining Hanson and Courtis would render Hanson unsatisfactory for its intended purpose because it would require the portable telephones and the system 107 to be combined. Hanson does teach, suggest or disclose combining the portable telephones and the voice-dialing system. Courtis would be rendered unsatisfactory for its intended purpose because an apparatus separate from the radiotelephone would be required to carry out the feature taught. Courtis does not teach, suggest or disclose an apparatus separate from the radiotelephone to carry out the feature.

In view of the foregoing, Applicants respectfully submit that claim 29 is patentably distinct from Hanson and Courtis, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 29 be withdrawn.

Claims 30-35 depend either directly or indirectly from claim 29. Accordingly, Applicants respectfully request that the rejection of claims 30-35 be withdrawn for at least the same reasons as those presented above in connection with claim 29 because Hanson and Courtis, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 29.

Claim 36 has been amended to recite "providing a user of the wireless communication device with a first prompt." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27. Hanson and Courtis, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states "system 107 proceeds conventionally, at step 224, by asking the caller to either repeat the tag or to speak a new tag." Hanson, col. 4, lines 12-14. The system 107 asking the user does not teach, suggest or disclose "providing a user of the wireless communication device with a first prompt" because Hanson clearly teaches that the system 107 is completely separate from the portable telephones. See Figure 1 of Hanson.

Courtis states:

> The radiotelephone provides a feature whereby a user may generate using the headset the voice tags, names, and/or telephone numbers . . . the user

> presses the button 33 on the headset and may be prompted by a sound or voice in the earpiece.

Courtis, col. 4, lines 36-44.

While Courtis teaches "the user . . . may be prompted by a sound or voice in the earpiece," Applicants submit that combining Hanson and Courtis would render either Hanson or Courtis unsatisfactory for its intended purpose. See MPEP § 2145. For example, Hanson teaches (as provided above) that system 107 asks the user to repeat the voice tag. As previously mentioned, the system 107 of Hanson is clearly separate from the wireless communication device (i.e., telephone of Courtis). As such, combining Hanson and Courtis would render Hanson unsatisfactory for its intended purpose because it would require the portable telephones and the system 107 to be combined. Hanson does teach, suggest or disclose combining the portable telephones and the voice-dialing system. Courtis would be rendered unsatisfactory for its intended purpose because an apparatus separate from the radiotelephone would be required to carry out the feature taught. Courtis does not teach, suggest or disclose an apparatus separate from the radiotelephone to carry out the feature.

In view of the foregoing, Applicants respectfully submit that claim 36 is patentably distinct from Hanson and Courtis, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 36 be withdrawn.

Claims 37-38 depend directly from claim 36. Accordingly, Applicants respectfully request that the rejection of claims 37-38 be withdrawn for at least the same reasons as those presented above in connection with claim 36 because Hanson and Courtis, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 36.

Claim 39 has been amended to recite "informing a user of the wireless communication device of an option." Support for this amendment may be found in Applicants' specification, page 7, lines 23-27. Hanson and Courtis, alone or in combination, do not teach, suggest or disclose this claim element.

Hanson states "[s]ystem 107 then asks the caller if he or she wants to complete the call to this number." Hanson, col. 4, lines 48-89. The system 107 asking the user does not teach, suggest or disclose "informing a user of the wireless communication device of an option"

because Hanson clearly teaches that the system 107 is completely separate from the portable telephones. See Figure 1 of Hanson.

Courtis states:

> The radiotelephone provides a feature whereby a user may generate using the headset the voice tags, names, and/or telephone numbers . . . the user presses the button 33 on the headset and may be prompted by a sound or voice in the earpiece.

Courtis, col. 4, lines 36-44.

While Courtis teaches "the user . . . may be prompted by a sound or voice in the earpiece," Applicants submit that combining Hanson and Courtis would render either Hanson or Courtis unsatisfactory for its intended purpose. See MPEP § 2145. For example, Hanson teaches (as provided above) that system 107 asks the user if he or she wants to complete the call. As previously mentioned, the system 107 of Hanson is clearly separate from the wireless communication device (i.e., telephone of Courtis). As such, combining Hanson and Courtis would render Hanson unsatisfactory for its intended purpose because it would require the portable telephones and the system 107 to be combined. Hanson does teach, suggest or disclose combining the portable telephones and the voice-dialing system. Courtis would be rendered unsatisfactory for its intended purpose because an apparatus separate from the radiotelephone would be required to carry out the feature taught. Courtis does not teach, suggest or disclose an apparatus separate from the radiotelephone to carry out the feature.

In view of the foregoing, Applicants respectfully submit that claim 39 is patentably distinct from Hanson and Courtis, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 39 be withdrawn.

Claims 40-41 depend directly from claim 39. Accordingly, Applicants respectfully request that the rejection of claims 40-41 be withdrawn for at least the same reasons as those presented above in connection with claim 39 because Hanson and Courtis, alone or in combination, do not teach, suggest or disclose all of the claim elements of claim 39.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants respectfully submit that all of the pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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